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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,841	01/12/2006	Michihiro Izumi	03500.103508.	2240
5514 7590 10/14/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
SING, SIMON P				
ART UNIT		PAPER NUMBER		
2614				
MAIL DATE		DELIVERY MODE		
10/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/564,841

Applicant(s)

IZUMI, MICHIIHIRO

Examiner

SIMON SING

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 9-12 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 9 is directed to a computer program (software) with is a non-functional descriptive material, or non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. US 6,310,942 in view of Sehgal US 6,618,165.

- 2.1 Regarding claims 1, 5 and 9, Bashoura teaches a system and method for sending image data (fax message) to a far-end terminal (opponent station), comprising:

communication control means (fax director 3) for sending a fax message to the far-end terminal (column 3, lines 53-62; column 4, lines 36-41),

if a far-end terminal has an IP address, sending the image data, not facsimile modulated, to the far-end terminal using an IP protocol (FTP), wherein the IP address is obtained from an telephone number of the far-end terminal (column 4, lines 54-67; column 5, lines 1-19), and

if a far-end terminal does not have an IP address, sending the image data, using facsimile modulation, to the far-end terminal through a telephone network PSTN 25 (column 5, lines 48-60).

Bashoura fails to teach sending the image data to a far-end terminal through an IP network via a gateway when the far-end terminal does not have an IP address.

However, Sehgal teaches that instead of sending a fax message through a PSTN, the fax message can be sent though Internet (IP network) via gateways (figure 1; column 1, lines 45-50; column 2, lines 31-50; column 3, lines 7-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bashoura reference with the teaching of Sehgal, so that image data would have been sent though an IP network via gateways when a destination terminal did not have an IP address. The motivation of such a modification was to reduce cost of transmitting the image data through PSTN as taught by Sehgal (Sehgal: column 1, lines 47-50).

2.2 Regarding claims 2, 6 and 10, the modified Bashoura reference teaches that when a far-end (destination) terminal does not have an IP address, the image data is first facsimile modulated, and then is digitally encoded by a gateway.

Also as well known in the art, an sending fax machine generates and sends a 1100 Hz CNG tone to a receiving fax machine, and the receiving fax machine generates and sends back a 2100 Hz CED tone.

2.3 Regarding claims 3, 7 and 11, Bashoura teaches whether using facsimile modulation for sending the image data is based on the far-end terminal's telephone number (column 4, lines 54-67; column 5, lines 1-20, 48-60).

2.4 Regarding claim 4, 8 and 12, Bashoura teaches sending the image data using the IP address of the far-end terminal (column 4, line 54 to column 5, line 20).

2.5 Regarding claims 13-15, the modified Bashoura reference teaches digitally encoding the fax modulated image data by a first (originating) gateway 106 of Sehgal.

Conclusion

3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

/Simon Sing/

Primary Examiner, Art Unit 2614